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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,509	09/20/2000	Noah Prywes	367059-101	6955

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STUART RUDOLER LLC
ATTN: DOCKET CLERK
2 BALA PLAZA, SUITE 300
BALA CYNWYD, PA 19004

EXAMINER

SHINGLES, KRISTIE D

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,509

Applicant(s)

PRYWES, NOAH

Examiner

Kristie Shingles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 8, 35-37, 43, 46, 47, 50 and 53 is/are pending in the application.
- 4a) Of the above claim(s) 58-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 8, 35-37, 43, 46, 47, 50 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

*Applicant has cancelled claims 2-4, 6, 7, 9-34, 38-42, 44, 45, 48, 49, 51, 52 and 54-57.
Claims 58-68 have been withdrawn.*

Claims 1, 5, 8, 35-37, 43, 46, 47, 50 and 53 are pending.

Response to Arguments

1. Applicant's arguments, see Remarks pages 11-13, filed 4/6/2005, with respect to the rejection(s) of claim(s) 1-57 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of in view of *Link II et al* (US 6,738,616) and further in view of *Owens et al* (US 2004/0005040).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 5, 8, 43, 46, 47, 50 and 53** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nielsen* (US 6,108,688) in view of *Link II et al* (US 6,738,616).

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a. **Per claims 1, 46 and 47** (differ only by statutory class), *Nielsen* teaches a method, system, computer-readable medium of automatically forwarding a response to a message to the sender of the message, comprising:

- (a) prompting the sender to provide a message; (b) prompting the sender to identify a recipient, the recipient having a plurality of associated contact numbers (col.1 lines 44-48, col.4 lines 13-19, col.8 lines 10-18 and 20-27; where if the system is able to contact the recipient by pager, email, phone, etc. it must also be able to associate each contact number with the proper receiving device to be able to execute the proper method of contact);
- (d) sending the message provided in response to step (a) to the associated contact number to which the message has not yet been sent; (e) prompting the recipient of the message to provide a reply to the message; (f) waiting at least a predetermined amount of time; (g) if no response to the message is received, repeating steps (d) through (g) with respect to the next associated contact number until a response is received or the message has been sent to all associated contact numbers; and (h) forwarding the response to the sender (col.2 lines 4-30 and lines 57-67; where the email address of the recipient is ranked as first to contact and after no response a phone number, pager number, or faxed number is ranked next to contact the recipient).

Nielsen fails to explicitly teach prompting a user to rank the associated contact numbers. However, *Link II et al* teach (c) prompting a user to rank the associated contact numbers relating to the recipient identified in response to step (b) from highest to lowest; (d) sending the message provided in response to step (a) to the highest ranked associated contact number to which the message has not yet been sent; (e) prompting the recipient of the message to provide a reply to the message; (f) waiting at least a predetermined amount of time; (g) if no response to the message is received, repeating steps (d) through (g) with respect to the next highest ranked associated contact number until a response is received or the message has been sent to all associated contact numbers (Figure 9, col.3 lines 38-56, col.5 lines 14-28, col.7 lines 50-61, col.15 line 43-col.16 line 45). It would have been obvious to one of ordinary skill in the

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art at the time the invention was made to combine the teachings of *Nielsen* with *Link II et al* by prompting a user to rank the associated contact numbers because the sender may know which contact numbers the recipient is more likely to be able to be reached at thus decreasing response time because there will be fewer loops through the contact list before the recipient responds to the message thus making the system more efficient.

b. **Per claim 5**, *Nielsen* in view of *Link II et al* teach the method of claim 1, *Nielsen* further teach wherein the channel of communication utilized by the recipient for sending the response is different from the channel of communication utilized by the sender for sending the message (col.2 lines 4-30).

c. **Per claim 8**, *Nielsen* in view of *Link II et al* teach the method of claim 1, *Nielsen* further teach wherein the channel of communication utilized by the sender for sending the message is by automated telephone call (col.2 lines 28-30).

d. **Claim 50** is substantially similar to claim 8 and is therefore rejected under the same basis.

e. **Per claim 43**, *Nielsen* in view of *Link II et al* teach the method of claim 1, *Nielsen* further teach wherein the message provided by the sender in response to step (a) comprises a plurality of questions; and wherein the recipient is prompted in step (e) to provide an answer to each question in the sender's message (col.3 lines 8-26).

f. **Per claim 53**, *Nielsen* in view of *Link II et al* teach the method of claim 47, *Nielsen* further teach wherein said input device comprises a microphone (col.3 lines 36-40; *Link II et al*: col.5 lines 14-19).

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4. **Claims 35-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Nielsen* (US 6,108,688) in view of *Link II et al* (US 6,738,616) and further in view of *Owens et al* (US 2004/0005040).

a. **Per claim 35**, *Nielsen* in view of *Link II et al* teach the method of claim 1 as applied above, yet fail to explicitly teach, further comprising: (i) converting a verbal message provided by the sender in response to step (a) into textual form. However, *Owens et al* teach a text-to-voice converter enabling the conversion textual messages into voice messages and vice-versa (Abstract, Figure 1, page 1 paragraph 0009-00010, page 2 paragraphs 0013-0014). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Nielsen* and *Link II et al* with *Owens et al* to provision text-to-voice/speech conversion in order to adequately convert the messages into the format appropriate for the receiving device.

b. **Claim 37** is substantially similar to claim 35 and is therefore rejected under the same basis.

c. **Per claim 36**, *Nielsen* and *Link II et al* with *Owens et al* teach the method of claim 35, *Nielsen* further teach wherein the message is sent to at least one recipient by e-mail (col.1 lines 54-57; *Link II et al*: col.7 lines 55-61; *Owens et al*: page 1 paragraphs 0009-00010).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Weiss et al (6,313,734), Wick et al (5,796,394), Brachman et al (6,501,838),

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Wierzbitzki et al (6,807,268), Myers et al (2004/0057562), Ditzik (6,167,376), Owens et al (6,633,630).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds


JASON CARDONE
SUPERVISORY PATENT EXAMINER